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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Group Art Unit 1724

In re

Patent Application of

James Daleiden

Application No. 10/680,763

Confirmation No. 5228

Filed: October 7, 2003

Examiner: Pham, Minh Chau Thi

"SPRING LOADED AIR CLEANER COVER"

I, Bridget Laack, hereby certify that this correspondence is being deposited with the US Postal Service as first class mail in an envelope addressed to Mail Stop Amendment Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date of my signature.

Bridget Laack
Signature

May 30, 2006
Date of Signature

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant has appealed from the final rejection dated December 5, 2005 and the Notice of Panel Decision from Pre-Appeal Brief Review mailed April 7, 2006. Applicant previously sent a check for $500.00 in payment of the fee required under 37 CFR 41.20(b)(1). A check in the amount of $500.00 is included in payment of the fee required under 37 CFR 41.20(b)(2). Applicant has requested herewith a one-month extension of time extending the due date of the Appeal Brief to June 7, 2006. A check in the amount of $120.00 is included for the one-month extension. Please charge or credit Deposit Account No. 13-3080 with any underpayment or overpayment of fees associated with the filing of this Appeal Brief.

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(1) Real Party in Interest.

The real party in interest is Briggs & Stratton Corporation, 12301 West Wirth Street, Wauwatosa, WI 53222.

(2) Related Appeals and Interferences.

A Pre-Appeal Brief Review was requested on February 20, 2006. A panel decision was mailed on April 7, 2006 stating that at least one issue remains for appeal. A copy of the decision is included in Appendix C.

(3) Status of Claims.

Claims 1-40 are currently pending and are attached as Appendix A. Claims 1-40 are currently rejected. Specifically, claims 1-4, 16, 17, 28, and 29 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ernst (U.S. Patent No. 6,231,630). In addition, claims 5-15, 18-27 and 30-40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over any one of Erdmannsdorfer (U.S. Patent No. 4,632,682), Uebelhoer (U.S. Patent No. 5,429,101), and Kasten (U.S. Patent No. 2,413,769). Applicant appeals the rejections of claims 1-40.

(4) Status of Amendments.

No amendments have been filed since the date of the Final Rejection.

(5) Summary of Claimed Subject Matter.

Independent claim 1 defines a filter device (20) for an engine (15) that is operable to support a filter element (40). *See for example, specification, page 3, lines 20-21 and page 4,* *lines 1-2.* The filter device (20) includes a housing that defines a filter receiving space (45) having a first end and a second end. *See for example, specification, page 4, line 3.* The first end and second end define an axial length therebetween. *See for example, specification, page 1, lines 20-21.* A biasing element (105) is integrally-formed as one piece with the housing and is disposed adjacent the first end. *See for example, specification, page 6, lines 9-10.*

Claims 2-10 and 12-13 and 15 depend from claim 1 and add additional limitations. For example, claim 5 depends directly from claim 1 and adds that the biasing element (105) includes a leaf spring (133) formed as part of the housing. *See for example, specification, page 6, lines 9-10.* The leaf spring (133) deflects in response to contact with the filter element (40). *See for example, specification, page 6, lines 16-19.*

Claim 11 depends directly from claim 1 and adds that the biasing element (105a) is integrally-formed with a bottom portion (30a) of the housing, and wherein the bottom portion (30a) deflects in response to contact with the filter element (40). *See for example, specification, page 7, lines 9-13, and Fig. 5.*

Claim 13 depends directly from claim 1 and adds that the biasing element (105a) includes a cantilever annular ring member (145). *See for example, specification, page 7, lines 10-12, and Fig. 5.*

Claim 14 depends directly from claim 1 and adds that the housing includes a cover (35) and the biasing element (105) is formed integral with the cover (35). *See for example, specification, page 6, lines 9-10.*

Claim 15 depends from claim 14, which depends from claim 1, and adds that the cover (35) includes at least one slot (140) that at least partially defines the biasing element (105). *See for example, specification, page 6, lines 10-12.*

Independent claim 16 defines an air cleaner assembly (20) for an engine (15). *See for example, specification, page 3, lines 20-21.* The air cleaner (20) includes a base (30) having a filter support (80) and a base engagement portion (95), and a filter element (40) that defines a longitudinal direction. *See for example, specification, page 4, lines 1-2, page 4, lines 21-22, and page 5, lines 6-7.* A cover (35) includes an integrally formed biasing element (105) and a cover engagement portion (110). *See for example, specification, page 4, lines 1-2, and page 5, lines 13-14.* The base engagement portion (95) is interconnected with the cover engagement portion (110) to position the biasing member (105) adjacent the filter element (40) to bias the filter element (40) in the longitudinal direction. *See for example, specification, page 5, lines 21-25 and page 2, lines 3-5.*

Claims 17-18, 20-22, and 24-27 depend from claim 16 and add additional limitations. For example, claim 18 depends from claim 16 and adds that the biasing element (105) includes a leaf spring (133) formed as part of the cover (35). *See for example, specification, page 6, lines 9-10.* The leaf spring (133) deflects in response to contact with the filter element (40). *See for example, specification, page 6, lines 16-19.*

Claim 19 depends directly from claim 16 and adds that the biasing element (105) is formed as part of a top portion (135) of the cover (35). *See for example, specification, page 6, lines 9-10.*

Claim 23 depends directly from claim 16 and adds that the biasing element (105a) is integrally-formed with a bottom portion (30a) of the base (30), and wherein the bottom portion (30a) deflects in response to contact with the filter element (40). *See for example, specification, page 7, lines 9-13, and Fig. 5.*

Claim 25 depends directly from claim 16 and adds that the biasing element (105a) includes a cantilever annular ring member (145). *See for example, specification, page 7, lines 10-12, and Fig. 5.*

Claim 26 depends from claim 16 and adds that the cover (35) includes at least one slot (140) that at least partially defines the biasing element (105). *See for example, specification, page 6, lines 10-12.*

Independent claim 28 defines a cover (35) for use with an engine filter base (30) and a filter element (40). *See for example, specification, page 4, lines 1-2.* The cover (35) includes a shell and a biasing element (105) integrally-formed as one piece with the shell. *See for example, specification, page 5, lines 13-14, and page 2, lines 7-9.* An attachment portion (95) is connected to the shell and is adapted to be interconnected to the filter base (30) such that the filter element (40) is sandwiched between the biasing element (105) and the filter base (30). *See for example, specification, page 6, lines 16-23.*

Claims 29-40 depend from claim 28 and add additional limitations. For example, claim 31 depends from claim 28 and adds that the biasing element (105) includes a leaf spring (133). *See for example, specification, page 6, lines 9-10.*

Claim 32 depends directly from claim 28 and adds that the biasing element (105) includes a slot (140) that at least partially defines the biasing element (105). *See for example, specification, page 6, lines 10-12.*

Claim 33 depends from claim 32 and adds that a second slot (140) is disposed a distance from the first slot (140) and that the first slot (140) and the second slot (140) cooperate to at least partially define the biasing element (105). *See for example, specification, page 6, lines 10-12 and Fig. 3.*

(6) Grounds of Rejection to be Reviewed on Appeal.

Whether claims 1-4, 16, 17, 28, and 29 are unpatentable under 35 U.S.C. §102(b) over Ernst (U.S. Patent No. 6,231,630). In addition, whether claims 5-15, 18-27 and 30-40 are unpatentable under 35 U.S.C. §103(a) in view of any one of Erdmannsdorfer (U.S. Patent No. 4,632,682), Uebelhoer (U.S. Patent No. 5,429,101), and Kasten (U.S. Patent No. 2,413,769). In light of the foregoing, Applicants appeal the rejection of claims 1-40.

(7) Argument.

In order for a reference to anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131.01 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." MPEP § 2131.01 citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In evaluating the scope of the claims, the Examiner must give the claims the broadest possible scope. However, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. MPEP §2111 citing *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (The Board's construction of the claim limitation "restore hair growth" as requiring the hair to be returned to its original state was held to be an incorrect interpretation of the limitation. The court held that, consistent with applicant's disclosure and the disclosure of three patents from analogous arts using the same phrase to require only some increase in hair growth, one of ordinary skill would construe "restore hair growth" to mean that the claimed method increases the amount of hair grown on the scalp, but does not necessarily produce a full head of hair.).

To establish a *prima facie* case of obviousness, the Examiner must meet three basic criteria. *See M.P.E.P.* § 706.02(j) and 2143.

> First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art, not in applicants' disclosure.

Id. The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventors have done. *M.P.E.P.* § 706.02(j); *see also In re Rougget*, 149 F.3d 1350, 1355 (Fed. Cir. 1998). In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from Appellant's disclosure. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 U.S.P.Q.2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); In re Vaeck, 947 F.2d at 493, 20 U.S.P.Q.2d at 1442; MPEP §2143. The Examiner can only establish a *prima facie* case of obviousness by pointing out some objective teaching in the prior art references themselves that would lead one of ordinary skill in the art to combine the relevant teachings and the references. In re Fine, 837 F.2d at 1074, 5 U.S.P.Q.2d at 1598-99; In re Jones, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1943-44 (Fed.

Cir. 1992); MPEP §2143.01. "Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." ATD Corp. v. Lydall, Inc., 159 F. 3d 534, 546 (Fed. Cir. 1998).

In addition, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. In re Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984); In re Mills, 916 F.2d 680, 682, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); MPEP §2143.01.

Further, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d at 902, 221 U.S.P.Q. at 1127 (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were prima facie obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.); MPEP §2143.01.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). *MPEP 2143.01.*

To properly establish a prima facie obviousness rejection under 35 U.S.C. §103,

> the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

MPEP §2142. Thus, hindsight based on the applicant's disclosure cannot be used to establish an obviousness rejection. *See id.*

In addition, while legal precedent may be used as the basis for an obviousness rejection, the prior legal decision must be sufficiently similar to the application. See MPEP §2144. "[I]f the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court." MPEP §2144.04. However, it is not appropriate for the Examiner to rely solely on case law to support an obviousness rejection if the applicant has demonstrated the criticality of the limitation in question. See MPEP §2144. "If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection." MPEP §2144.04 (emphasis added)

A – Rejection of claims 1-4, 16, 17, 28, and 29 under 35 U.S.C. §102(b) over Ernst (U.S. Patent No. 6,231,630)

i: Claims 1-4

Independent claim 1 defines a filter device for an engine that is operable to support a filter element. The filter device includes a housing that defines a filter receiving space having a first end and a second end. The first end and second end define an axial length therebetween. A biasing element is integrally-formed as one piece with the housing and is disposed adjacent the first end.

Ernst does not teach or suggest, among other things, a filter device that includes a biasing element integrally-formed as one piece with the housing. Rather, Ernst discloses an air filter for the intake of an internal combustion engine that includes a housing and a filter insert. As shown in Fig. 3, the housing 30 includes a spring clip 38 that is coupled to the housing 30. The spring clip 38 engages a filter insert 26 that holds a filter element in the desired position. As is clearly illustrated, the spring clip 38 is not integrally-formed as one piece with the housing 30. As further evidence that these are indeed two separate pieces and not one, Fig. 2 of Ernst, which illustrates the air filter of Fig. 3 in the open position rather than the closed position, does not include the spring clip 38.

The Examiner points to Fig. 3 and col. 3, lines 21-31 in support of the 35 U.S.C. §102(b) rejections. Fig. 3 is a section view of the air filter that clearly shows the housing 30 and the spring clip 38 cross-hatched using a different pattern. As noted in the MPEP, "various parts of a cross section of the same item should be hatched in the same manner and . . . [t]he hatching of juxtaposed different elements must be angled in a different way." *37 C.F.R. §1.84 (h)(3) (emphasis added).* Ernst discloses in Fig. 1 a different air filter arrangement, but also clearly shows that the spring clip (bow clamp 40) is separate from the filter housing. As discussed, Fig. 2 illustrates the air filter in an open position and in this position, no spring clip 38 is shown. If the spring clip is integrally-formed as one piece with the housing, it cannot be removed from the housing without destroying the component.

Furthermore, the text of col. 3, lines 21-31 does not support the Examiner's contention that Ernst anticipates claim 1, the relevant text reads:

> FIG. 3 shows the closed position of the air filter shown in FIG. 2. Corresponding parts are provided with the same reference numbers. A lip 36 of the cover 25 engages a groove 37 in the housing. The closing of the cover on the housing is accomplished by a catch or, as shown here, by a spring clip 38. At the left end of the cover and on the two sides, not shown here, the cover lies upon a circumferential seal 39 of the housing and thus seals the raw air chamber against the entry of unwanted air. The filter element 35 is configured as a holder for the filter insert 26 and can be exchanged without difficulty.

Ernst, col. 3, lines 21-31. There is no mention of integrally forming the housing and the biasing member as a single component within this portion of the text, or anywhere within the disclosure of Ernst.

In an effort to refute Applicant's arguments, the Examiner simply states that "[i]t is clearly shown in Figure 3 that the spring clip (38) is integrally formed as one piece with the housing (30) (see 'round' connection between the top of housing (30) and the spring clip (38)." *Office action dated December 5, 2005, page 3.* However, this argument is self-defeating as the Examiner himself notes a *connection* between the housing 30 and the spring clip 38. Parts that are integrally-formed as a single part do not have a connection between them, but rather are a single piece.

Thus, the Examiner's argument essentially consists of unsupported statements that Ernst teaches a housing and biasing member integrally formed as a single piece. However, the Examiner can point to no statement or figure within Ernst that clearly shows or even hints at the possibility that these components are integrally formed as a single piece.

In light of the foregoing, Ernst does not anticipate claim 1. Furthermore, claim 1 is not obvious in view of Ernst. As discussed above, all the limitations of claim 1 are not disclosed in Ernst, nor is there a teaching or suggestion within Ernst that would lead one of ordinary skill in the art to integrally form a biasing member and a housing as a single piece. As such, claim 1 is not anticipated or obvious in view of Ernst. Rather, claim 1 is allowable over Ernst. Claims 2-4 depend from claim 1 and add additional limitations. Thus, claims 2-4 are also allowable over Ernst.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-4 and allowance of claims 1-4.

ii: Claims 16-17

Independent claim 16 defines an air cleaner assembly for an engine. The air cleaner assembly includes a base including a filter support and a base engagement portion, and a filter element defining a longitudinal direction. A cover includes an integrally formed biasing element and a cover engagement portion. The base engagement portion is interconnected with the cover engagement portion to position the biasing member adjacent the filter element to bias the filter element in the longitudinal direction.

Ernst does not teach or suggest, among other things, an air cleaner that includes a cover that includes an integrally-formed biasing element. As discussed with regard to claim 1, Ernst discloses a filter assembly that includes a spring clip 38 that engages the housing 30 to hold the filter housing 26 and filter element 35 in the desired position. The spring clip 38 is separate from the housing 30 and may either engage the housing 30 or may be pinned to the housing 30 during assembly. However, there is nothing in Ernst that suggests that the spring clip is, or even could be, integrally-formed as part of the housing.

The Examiner attempts to overcome the deficiencies of Ernst by simply stating that Fig. 3 illustrates a spring clip 38 that is integrally-formed with the cover 30. However, there is no support in Ernst for this contention. While the spring clip 38 is coupled to and engages the cover, there simply is no support for the contention that the spring clip 38 is integrally formed with the cover 30.

In light of the foregoing, Ernst does not anticipate claim 16. Furthermore, claim 16 is not obvious in view of Ernst. As discussed above, all the limitations of claim 16 are not disclosed in Ernst, nor is there a teaching or suggestion within Ernst that would lead one of ordinary skill in the art to employ a cover including an integrally-formed biasing element. As such, claim 16 is not anticipated or obvious in view of Ernst. Rather, claim 16 is allowable over Ernst. Claim 17 depends from claim 16 and adds additional limitations. Thus, claim 17 is also allowable over Ernst.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 16-17 and allowance of claims 16-17.

iii: Claims 28-29

Independent claim 28 defines a cover for use with an engine filter base and a filter element. The cover includes a shell, a biasing element integrally-formed as one piece with the shell, and an attachment portion connected to the shell. The attachment portion is adapted to be interconnected to the filter base such that the filter element is sandwiched between the biasing element and the filter base.

Ernst does not teach or suggest a cover for an engine filter that includes a shell and a biasing element integrally-formed as one piece with the shell. As discussed with regard to claims 1 and 16, Ernst discloses a filter assembly that includes a spring clip 38 that engages the housing 30 to hold the filter housing 26 and filter element 35 in the desired position. The spring clip 38 is separate from the housing 30 and may either engage the housing 30 or may be pinned to the housing 30 during assembly. However, there is nothing in Ernst that suggests that the spring clip is, or even could be, integrally-formed as part of a shell.

The Examiner presents very little argument to overcome this deficiency. Rather, the Examiner relies on Fig. 3 and a strained interpretation of what is shown in Fig. 3. It is clear to Applicant that Fig. 3 illustrates a spring clip 38 that is separate from the housing 30. The two components are cross-hatched differently, thus clearly indicating to Applicant that they are different components. In addition, Fig. 2 shows the air filter in the open position. In this position, the spring clip 38 is omitted, further indicating that the spring clip 38 is not integrally-formed as part of the housing 30. Thus, the Examiner's contention that Fig. 3 clearly discloses the subject matter recited in claim 28 is unsupportable.

In light of the foregoing, Ernst does not anticipate claim 28. Furthermore, claim 28 is not obvious in view of Ernst. As discussed above, all the limitations of claim 28 are not disclosed in Ernst, nor is there a teaching or suggestion within Ernst that would lead one of ordinary skill in the art to provide a biasing element integrally-formed as one piece with the shell. As such, claim 28 is not anticipated or obvious in view of Ernst. Rather, claim 28 is allowable over Ernst. Claim 29 depends from claim 28 and adds additional limitations. Thus, claim 29 is also allowable over Ernst.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 28-29 and allowance of claims 28-29.

B – Rejection of claims 5-15, 18-27, and 30-40 under 35 U.S.C. §103(a) in view of any one of Erdmannsdorfer (U.S. Patent No. 4,632,682), Uebelhoer (U.S. Patent No. 5,429,101), and Kasten (U.S. Patent No. 2,413,769)

i: Claims 6-10, and 12

Claims 6-10 and 12 depend from claim 1 and are allowable for the reasons set forth with regard to claim 1.

In addition, Applicant respectfully submits that the Examiner has erred by failing to establish a *prima facie* case of obviousness with respect to claims 6-12 and 14 because the Examiner has not specifically pointed out how each and every limitation included in claims 6-12 and 14 is described or suggested in the cited prior art references. Specifically, the Examiner has failed to show a teaching or suggestion, from within the references themselves, of a biasing element integrally-formed as one piece with the housing.

Erdmannsdörfer discloses an oil-separating air filter that includes a housing 30, a filter 43, and a biasing element 46 (coil spring). However, the biasing element 46 is separate from the housing. Uebelhoer discloses a device similar to Erdmannsdörfer that includes a housing 30, a filter 43, and an unnumbered coil spring that is separate from the housing. Kasten discloses a filter that includes a housing 14, a filter 29, and a spring 34 (coil spring) that is separate from the housing 14 and the filter 29.

The Examiner acknowledges that none of the cited references teach or suggest a biasing member that is integrally-formed as one piece with a housing. To overcome this deficiency, the Examiner relies solely on legal precedent that is more than a century old, and simply states that this limitation is obvious "since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art." Office action dated July 6, 2005, page 3 citing Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

Applicant submits that the Examiner's reliance on case law for the §103(a) rejection is unsupportable with respect to the "biasing element integrally formed as one piece with the housing" limitation, included in claims 6-12 and 14.

It is not always appropriate for the Examiner to rely solely on case law to support an obviousness rejection. MPEP §2144.04. Specifically, "[i]f the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection." MPEP §2144.04 (emphasis added). In the present application, Applicant has included the limitation of a biasing member integrally-formed as one piece with a housing in each of claims 1-15. This limitation goes to the heart of the invention and is clearly critical for the proper function of the claimed device. Specifically, the claimed device has a reduced part count which reduces the cost of both manufacturing and assembly. To achieve the integration, Applicants developed a novel biasing element that functions as desired. As such, Applicant contends that an obviousness rejection based solely on case law is improper.

Furthermore, the proper use of case law as the basis for an obviousness rejection requires that the Examiner consider all the relevant facts in the application and compare these to the facts in the prior legal decision. See MPEP §2144. Thus, "[i]f the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court." MPEP §2144.04. However, the fact that Howard has held the combination of two elements into one element to be obvious does not mean *all* such combinations are obvious. Such a conclusion based on this single case is overly broad. In fact, MPEP §2144.04 V(B), refers to a much more recent case where the court held that the combination of two components into a single integral component was not obvious. See Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). In Schenck,

> [c]laims were directed to a vibratory testing machine (a hard-bearing wheel balancer) comprising a holding structure, a base structure, and a supporting means which form "a single integral and gaplessly continuous piece." Nortron argued that the invention is just making integral what had been made in four bolted pieces. The court found this argument unpersuasive and held that the claims were patentable because the prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure, showing insight that was contrary to the understandings and expectations of the art.

MPEP §2144.04 V(B).

The facts of the present application are more similar to Schenck than to Howard. Specifically, in Howard, the patent was directed to a grate for a stove. The prior art contained all of the elements of the grate, except that it was cast in two pieces, while the patented device was cast as one piece. See Howard at 169-170. The court concluded "it involves no invention to cast in one piece an article which has formerly been cast in two pieces, and put together." Howard v. Detroit Stove Works, 150 U.S. 164, 170 (1893). Clearly, both components discussed in Howard could be made as one piece as each component was originally made using the same manufacturing process (casting), using the same material. Furthermore, the two components formed a grate wherein the two components did not have to move with respect to one another.

The prior art references cited by the present Examiner include a housing and a coil spring or a spring clip. Unlike Howard, the coil springs or spring clip are made from a material, such as metal, using a manufacturing process that is quite different from the material (e.g., plastic) and process (e.g., injection molding) that can be used to make the housing. In addition, the coil spring or spring clip shown in the prior art must be able to move with respect to the housing, a feature likely not required by the grate of Howard. Thus, the two separate components in the prior art of the present invention, i.e., a housing and a spring, their relationship to each other, and the different methods used to manufacture these two components in the prior art, are not sufficiently similar to the two grate components in Howard to support an obviousness rejection based *solely* on Howard.

Like Schenck, in the present application, the prior art perceived a need for a separate spring. However, the Applicant has eliminated the need for this separate spring by integrally forming a biasing element as one piece with the housing, thereby saving money and simplifying the construction of the filter device. To accomplish this, the Applicant has shown "insight that was contrary to the understandings and expectations of the art" by employing a different type of spring than that disclosed in the prior art, and forming that spring from the same material as the housing, using the same manufacturing process, in a way that allows the spring to move with respect to the housing. See MPEP §2144.04 V(B) citing Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). This is not taught or suggested by the prior art.

In light of the foregoing, Erdmannsdörfer, Uebelhoer, and Kasten, alone or in combination, do not teach or suggest each and every limitation of claims 6-10 and 12. As such, claims 6-10 and 12 are allowable.

ii: Claim 5

Claim 5 depends from claim 1 and adds that the biasing element includes a leaf spring formed as part of the housing, the leaf spring deflecting in response to contact with the filter element.

Because claim 5 depends from claim 1, the arguments presented above with respect to claims 6-10 and 12, as well as those presented with regard to claim 1 are equally applicable to claim 5.

In addition, none of Erdmannsdörfer, Uebelhoer, or Kasten, alone or in combination, teach or suggest the use of a leaf spring. Rather, Erdmannsdörfer discloses an oil-separating air filter that includes a biasing element 46 in the form of a coil spring. Uebelhoer discloses a similar device that includes an unnumbered coil spring. Kasten discloses a filter that includes a spring 34 illustrated as a coil spring.

Thus, each reference cited by the Examiner discloses a coil spring. There is no teaching or suggestion that would lead one of ordinary skill in the art to employ a leaf spring or believe a leaf spring could be employed, much less a leaf spring formed as part of the housing. The Examiner makes no attempt to overcome this deficiency, but rather simply states that the claimed subject matter is obvious. The Examiner's statement alone cannot support a 35 U.S.C. §103(a) rejection.

In light of the foregoing, Erdmannsdörfer, Uebelhoer, and Kasten, alone or in combination, do not teach or suggest each and every limitation of claim 5. As such, claim 5 is allowable.

iii: Claim 11

Claim 11 depends from claim 1 and further defines the biasing element as being integrally-formed with a bottom portion of the housing, and wherein the bottom portion deflects in response to contact with the filter element.

Because claim 11 depends from claim 1, the arguments presented above with respect to claims 6-10 and 12, as well as those presented with respect to claim 1 are equally applicable to claim 11.

In addition, none of Erdmannsdörfer, Uebelhoer, or Kasten, alone or in combination, teach or suggest a biasing element integrally-formed with a bottom portion of the housing such that the bottom portion deflects in response to contact with the filter element. The Examiner makes no attempt to overcome this deficiency nor does the Examiner attempt to identify a component in the prior art references that is analogous to the claimed structure. Rather, the Examiner simply states that the claimed subject matter is obvious. Again, the Examiner's statement alone cannot support a 35 U.S.C. §103(a) rejection.

In light of the foregoing, Erdmannsdörfer, Uebelhoer, and Kasten, alone or in combination, do not teach or suggest each and every limitation of claim 11. As such, claim 11 is allowable.

iv: Claim 13

Claim 13 depends from claim 1 and further defines a biasing element including a cantilevered annular ring member.

Because claim 13 depends from claim 1, the arguments presented above with respect to claims 6-10 and 12, as well as those presented with respect to claim 1 are equally applicable to claim 13.

In addition, none of Erdmannsdörfer, Uebelhoer, or Kasten, alone or in combination, teach or suggest the use of a cantilevered annular ring member, and the Examiner has not pointed out how this limitation is taught or suggested in any of these references. The Examiner makes no attempt to overcome this deficiency nor does the Examiner attempt to identify a component in the prior art references that is analogous to the claimed structure. Rather, the Examiner simply states that the claimed subject matter is obvious. Again, the Examiner's statement alone cannot support a 35 U.S.C. §103(a) rejection.

In light of the foregoing, Erdmannsdörfer, Uebelhoer, and Kasten, alone or in combination, do not teach or suggest each and every limitation of claim 13. As such, claim 13 is allowable.

v: Claim 14

Claim 14 depends from claim 1 and further defines that the housing includes a cover and the biasing element is formed integral with the cover.

Because claim 14 depends from claim 1, the arguments presented above with respect to claims 6-10 and 12, as well as those presented with respect to claim 1 are equally applicable to claim 14.

In addition, none of Erdmannsdörfer, Uebelhoer, or Kasten, alone or in combination, teach or suggest a biasing element integrally-formed with a cover. The Examiner makes no attempt to overcome this deficiency nor does the Examiner attempt to identify a component in the prior art references that is analogous to the claimed structure. Rather, the Examiner simply states that the claimed subject matter is obvious. As noted, the Examiner's statement alone cannot support a 35 U.S.C. §103(a) rejection.

In light of the foregoing, Erdmannsdörfer, Uebelhoer, and Kasten, alone or in combination, do not teach or suggest each and every limitation of claim 14. As such, claim 14 is allowable.

vi: Claim 15

Claim 15 depends from claim 1 and further defines a cover that includes at least one slot that at least partially defines the biasing element.

Because claim 15 depends from claim 1, the arguments presented above with respect to claims 6-10 and 12, as well as those presented with respect to claim 1 are equally applicable to claim 15.

In addition, none of Erdmannsdörfer, Uebelhoer, or Kasten, alone or in combination, teach or suggest the use of one or more slots to partially define a biasing element. The Examiner has not pointed out how this limitation is taught or suggested in any of these references. In fact, the Examiner has made no attempt to overcome this deficiency or to show an analogous component in the prior art. Rather, the Examiner simply states that the claimed subject matter is obvious. Again, the Examiner's statement alone cannot support a 35 U.S.C. §103(a) rejection.

In light of the foregoing, Erdmannsdörfer, Uebelhoer, and Kasten, alone or in combination, do not teach or suggest each and every limitation of claim 15. As such, claim 15 is allowable.

vii: Claims 20-22, 25, and 27

Claims 20-22, 25 and 27 depend from claim 16 and are allowable for the reasons set forth with regard to claim 16.

In addition, Applicant respectfully submits that the Examiner has erred by failing to establish a *prima facie* case of obviousness with respect to claims 20-22, 25 and 27 because the Examiner has not specifically pointed out how each and every limitation included in claims 20-22, 25 and 27 is described or suggested in the cited prior art references. Specifically, the Examiner has failed to show a teaching or suggestion, from within the references themselves, of a cover including an integrally-formed biasing element.

To overcome this deficiency, the Examiner has relied solely on case law that is more than a century old, and simply states that this limitation is obvious "since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art." Office action dated July 6, 2005 citing Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

As discussed with regard to claims 6-12 and 14, the reliance on Howard in this case is improper. The proper use of case law as the basis for an obviousness rejection requires that the Examiner consider all the relevant facts in the application and compare these to the facts in the prior legal decision. See MPEP §2144. "If the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court." MPEP §2144.04. As noted above, the facts of Howard are not sufficiently similar to those of the present case. In Howard, the two parts being combined were made from a similar material using a similar manufacturing process. As such, they could be easily combined into a single manufacturing step. In addition, the two components were not required to move with respect to one another. In the present case, the Examiner has cited four references that include biasing members and housings that would be made using two different and unique manufacturing processes. Specifically, coil springs and spring clips like those disclosed in the cited references are not generally cast or molded, thereby making it very difficult to integrally form these components with their respective housings.

Thus, the facts of the present case are much closer to those of Schenck in which the court held that the combination of two components into one component was not obvious. Like Schenck, in the present application, the prior art perceived a need for a separate spring. However, the Applicant has eliminated the need for this separate spring by integrally forming a unique biasing element as one piece with the housing, thereby saving money and simplifying the construction of the filter device.

The Examiner's blanket statement that "forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art" is overly broad. As Applicant has demonstrated, Schenck supports the opposite statement. In addition, the facts of the case relied upon by the Examiner are not sufficiently similar to the facts of the present case to support a rejection based solely on Howard.

In light of the foregoing, Erdmannsdörfer, Uebelhoer, and Kasten, alone or in combination, do not teach or suggest each and every limitation of claims 20-22, 25 and 27. As such, claims 20-22, 25 and 27 are allowable.

viii: Claim 18

Claim 18 depends from claim 16 and adds that the biasing element includes a leaf spring formed as part of the cover, the leaf spring deflecting in response to contact with the filter element.

Because claim 18 depends from claim 16, the arguments presented above with respect to claims 20-22, 25 and 27, as well as those presented with regard to claim 16 are equally applicable to claim 18.

In addition, none of Erdmannsdörfer, Uebelhoer, or Kasten, alone or in combination, teach or suggest the use of a leaf spring. Rather, Erdmannsdörfer discloses an oil-separating air filter that includes a biasing element 46 in the form of a coil spring. Uebelhoer discloses a similar device that includes an unnumbered coil spring. Kasten discloses a filter that includes a spring 34 illustrated as a coil spring.

Thus, each reference cited by the Examiner discloses a coil spring. There is no teaching or suggestion that would lead one of ordinary skill in the art to employ a leaf spring. The Examiner makes no attempt to overcome this deficiency, but rather simply states that the claimed subject matter is obvious. The Examiner's statement alone cannot support a 35 U.S.C. §103(a) rejection.

In light of the foregoing, Erdmannsdörfer, Uebelhoer, and Kasten, alone or in combination, do not teach or suggest each and every limitation of claim 18. As such, claim 18 is allowable.

ix: Claim 19

Claim 19 depends from claim 16 and further adds that the biasing element is formed as part of a top portion of the cover.

Because claim 19 depends from claim 16, the arguments presented above with respect to claims 20-22, 25 and 27, as well as those presented with regard to claim 16 are equally applicable to claim 19.

In addition, none of Erdmannsdörfer, Uebelhoer, of Kasten, alone or in combination, teach or suggest a biasing element formed as part of a top portion of the cover. The Examiner has not pointed out how this limitation is taught or suggested in any of these references, nor has the Examiner identified any structure in the cited prior art that might be analogous to the claimed structure. The Examiner makes no attempt to overcome this deficiency, but rather simply states that the claimed subject matter is obvious. Again, the Examiner's statement alone cannot support a 35 U.S.C. §103(a) rejection.

In light of the foregoing, Erdmannsdörfer, Uebelhoer, and Kasten, alone or in combination, do not teach or suggest each and every limitation of claim 19. As such, claim 19 is allowable.

x: Claim 23

Claim 23 depends from claim 16 and further adds that the biasing element is integrally-formed with a bottom portion of the base, and the bottom portion deflects in response to contact with the filter element.

Because claim 23 depends from claim 16, the arguments presented above with respect to claims 20-22, 25 and 27, as well as those presented with regard to claim 16 are equally applicable to claim 23.

In addition, none of Erdmannsdörfer, Uebelhoer, of Kasten, alone or in combination, teach or suggest a biasing element that is integrally-formed with a bottom portion of the base, the bottom portion deflecting in response to contact with the filter element. The Examiner has not pointed out how this limitation is taught or suggested in any of these references, nor has the Examiner identified any structure in the cited prior art that might be analogous to the claimed structure. The Examiner makes no attempt to overcome this deficiency, but rather simply states that the claimed subject matter is obvious. Again, the Examiner's statement alone cannot support a 35 U.S.C. §103(a) rejection.

In light of the foregoing, Erdmannsdörfer, Uebelhoer, and Kasten, alone or in combination, do not teach or suggest each and every limitation of claim 23. As such, claim 23 is allowable.

xi: Claim 25

Claim 25 depends from claim 16 and further defines a biasing element including a cantilevered annular ring member.

Because claim 25 depends from claim 16, the arguments presented above with respect to claims 20-22, 25 and 27, as well as those presented with regard to claim 16 are equally applicable to claim 25.

In addition, none of Erdmannsdörfer, Uebelhoer, of Kasten, alone or in combination, teach or suggest the use of a cantilevered annular ring member. The Examiner has not pointed out how this limitation is taught or suggested in any of these references, nor has the Examiner identified any structure in the cited prior art that might be analogous to the claimed structure. The Examiner makes no attempt to overcome this deficiency, but rather simply states that the claimed subject matter is obvious. Again, the Examiner's statement alone cannot support a 35 U.S.C. §103(a) rejection.

In light of the foregoing, Erdmannsdörfer, Uebelhoer, and Kasten, alone or in combination, do not teach or suggest each and every limitation of claim 25. As such, claim 25 is allowable.

xii: Claim 26

Claim 26 depends from claim 16 and further defines a cover that includes at least one slot that at least partially defines the biasing element.

Because claim 26 depends from claim 16, the arguments presented above with respect to claims 20-22, 25 and 27, as well as those presented with respect to claim 16 are equally applicable to claim 26.

In addition, none of Erdmannsdörfer, Uebelhoer, or Kasten, alone or in combination, teach or suggest the use of one or more slots to partially define a biasing element. The Examiner has not pointed out how this limitation is taught or suggested in any of these references. Furthermore, the Examiner has not pointed to any structure in any of the cited references that could be analogous to the claimed structure. In fact, the Examiner makes no attempt to overcome this deficiency, but rather simply states that the claimed subject matter is obvious. However, the Examiner's statement alone cannot support a 35 U.S.C. §103(a) rejection.

In light of the foregoing, Erdmannsdörfer, Uebelhoer, and Kasten, alone or in combination, do not teach or suggest each and every limitation of claim 26. As such, claim 26 is allowable.

xiii: Claims 34-40

Claims 34-40 depend from claim 28 and are allowable for the reasons set forth with regard to claim 28.

In addition, Applicant respectfully submits that the Examiner has erred by failing to establish a *prima facie* case of obviousness with respect to claims 34-40 because the Examiner has not specifically pointed out how each and every limitation included in claims 34-40 is described or suggested in the cited prior art references. Specifically, the Examiner has failed to show a teaching or suggestion, from within the references themselves, of a shell and a biasing element integrally-formed as one piece with the shell.

To overcome this deficiency, the Examiner has relied solely on case law that is more than a century old, and simply states that this limitation is obvious "since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art." Office action dated July 6, 2005 citing Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

As discussed with regard to claims 6-12 and 14, the reliance on Howard in this case is improper. The proper use of case law as the basis for an obviousness rejection requires that the Examiner consider all the relevant facts in the application and compare these to the facts in the prior legal decision. See MPEP §2144. "If the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court." MPEP §2144.04. As noted above, the facts of Howard are not sufficiently similar to those of the present case. In Howard, the two prior art parts being combined were made from a similar material using a similar manufacturing process prior to being combined. As such, they could be easily combined into a single manufacturing step. In addition, the two components were not required to move with respect to one another.

In the present case, the Examiner has cited four references that include biasing members and shells that would typically be made using two different and unique manufacturing processes. Specifically, the coil springs and spring clips of the cited references are generally not cast or molded, thereby making it difficult to integrally-form these components with their respective shells or housings.

Thus, the facts of the present case are much closer to those of Schenck in which the court held that the combination of two components into one component was not obvious. The prior art cited by the Examiner perceived a need for a separate spring, just as the prior art of Schenck perceived a need for a vibratory testing machine having a mechanisms to dampen resonance. However, the Applicant has shown "insight that was contrary to the understandings and expectations of the art" and eliminated the need for this separate spring by employing a different type of biasing element and integrally-forming the biasing element as one piece with the shell, thereby saving money and simplifying the construction of the filter device. See MPEP §2144.04 V(B) citing Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

The Examiner's blanket statement that "forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art" is overly broad. As Applicant has demonstrated, Schenck could be used to support the opposite conclusion. The facts of Howard are simply not sufficiently similar to the facts of the present case to support a rejection based solely on Howard.

In light of the foregoing, Erdmannsdörfer, Uebelhoer, and Kasten, alone or in combination, do not teach or suggest each and every limitation of claims 34-40. As such, claims 34-40 are allowable.

xiv: Claim 30

Claim 30 depends from claim 28 and adds that the shell, biasing element, and attachment member are injection molded as a single component.

Because claim 30 depends from claim 28, the arguments presented above with respect to claims 34-40, as well as those presented with regard to claim 28 are equally applicable to claim 30.

In addition, none of Erdmannsdörfer, Uebelhoer, or Kasten, alone or in combination, teach or suggest a cover that includes a shell, biasing element, and attachment member that are injection molded as a single component. Rather, each discloses a biasing element in the form of a coil spring. No mention is made regarding how the spring is formed. However, one of ordinary skill in the art would generally not employ an injection molding process to form a spring unless such a construction was specifically taught. Coil springs are generally formed from a metal, such as steel, which is not injection molded. In addition, each of the references relied upon by the Examiner discloses biasing members that are formed separate from their respective housings. The Examiner makes no attempt to overcome this deficiency, but rather simply states that the claimed subject matter is obvious. As noted, the Examiner's statement alone cannot support a 35 U.S.C. §103(a) rejection.

In light of the foregoing, Erdmannsdörfer, Uebelhoer, and Kasten, alone or in combination, do not teach or suggest each and every limitation of claim 30. As such, claim 30 is allowable.

xv: Claim 31

Claim 31 depends from claim 28 and adds that the biasing element includes a leaf spring.

Because claim 31 depends from claim 28, the arguments presented above with respect to claims 34-40, as well as those presented with regard to claim 28 are equally applicable to claim 31.

In addition, none of Erdmannsdörfer, Uebelhoer, or Kasten, alone or in combination, teach or suggest the use of a leaf spring. Rather, Erdmannsdörfer discloses an oil-separating air filter that includes a biasing element 46 in the form of a coil spring. Uebelhoer discloses a similar device that includes an unnumbered coil spring. Kasten discloses a filter that includes a spring 34 illustrated as a coil spring.

Thus, each reference cited by the Examiner discloses a coil spring. There is no teaching or suggestion that would lead one of ordinary skill in the art to employ a leaf spring. The Examiner makes no attempt to overcome this deficiency, nor does the Examiner point to structure in the prior art that could be analogous to the claimed structure. Rather, the Examiner simply states that the claimed subject matter is obvious. However, the Examiner's statement alone cannot support a 35 U.S.C. §103(a) rejection.

In light of the foregoing, Erdmannsdörfer, Uebelhoer, and Kasten, alone or in combination, do not teach or suggest each and every limitation of claim 31. As such, claim 31 is allowable.

xvi: Claim 32

Claim 32 depends from claim 28 and adds a slot that at least partially defines the biasing element.

Because claim 32 depends from claim 28, the arguments presented above with respect to claims 34-40, as well as those presented with regard to claim 28 are equally applicable to claim 32.

In addition, none of Erdmannsdörfer, Uebelhoer, or Kasten, alone or in combination, teach or suggest the use of a slot that at least partially defines the biasing element, and the Examiner has not pointed out how this limitation is taught or suggested in any of these references. The Examiner makes no attempt to overcome this deficiency, but rather simply states that the claimed subject matter is obvious. Again, the Examiner's statement alone cannot support a 35 U.S.C. §103(a) rejection.

In light of the foregoing, Erdmannsdörfer, Uebelhoer, and Kasten, alone or in combination, do not teach or suggest each and every limitation of claim 32. As such, claim 32 is allowable.

xvii: Claim 33

Claim 33 depends from claim 32 and further defines a second slot disposed a distance from the first slot, the first slot and the second slot cooperating to at least partially define the biasing element.

Because claim 33 depends from claim 32, the arguments presented above with regard to claim 32, claim 28, and claims 34-40 are equally applicable to claim 33.

In addition, none of Erdmannsdörfer, Uebelhoer, or Kasten, alone or in combination, teach or suggest the use of two slots spaced a distance from one another to at least partially define a biasing element, and the Examiner has not pointed out how this limitation is taught or suggested in any of these references. Again, the Examiner makes no attempt to overcome this deficiency, but rather simply states that the claimed subject matter is obvious. However, the

Examiner's statement alone cannot support a 35 U.S.C. §103(a) rejection.

In light of the foregoing, Erdmannsdörfer, Uebelhoer, and Kasten, alone or in combination, do not teach or suggest each and every limitation of claim 33. As such, claim 33 is allowable.

(9) Conclusion.

In view of the foregoing, reversal of the final rejection of claims 1-40 and allowance of claims 1-40 are respectfully requested.

Respectfully submitted,

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Docket No.: 018367-9798-00
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APPENDIX A

Listing of Claims:

What is claimed is:

1. (Original) A filter device for an engine and operable to support a filter element, the filter device comprising:

a housing defining a filter receiving space having a first end and a second end, the first end and second end defining an axial length therebetween; and

a biasing element integrally-formed as one piece with the housing and disposed adjacent the first end.

2. (Original) The filter device of claim 1, wherein the housing includes a first portion having a first engagement portion and a second portion having a second engagement portion.

3. (Original) The filter device of claim 2, wherein the first engagement portion includes tabs, and the second engagement portion includes slots sized to receive the tabs and interconnect the first portion to the second portion.

4. (Original) The filter device of claim 1, wherein at least one of the first end and the second end includes a radial retainer positioned to inhibit radial movement of the filter element.

5. (Original) The filter device of claim 1, wherein the biasing element includes a leaf spring formed as part of the housing, the leaf spring deflecting in response to contact with the filter element.

6. (Original) The filter device of claim 1, wherein the biasing element is formed as part of a top portion of the housing, and wherein the top portion deflects in response to contact with the filter element.

7. (Original) The filter device of claim 1, wherein the filter element is positioned within the filter receiving space such that the biasing element deflects to sandwich the filter element between the biasing element and the second end.

8. (Original) The filter device of claim 1, further comprising a filter element including a pleated filter media sandwiched between a first end cap and a second end cap.

9. (Original) The filter device of claim 8, wherein the first end cap is in contact with the biasing element and the second end cap is in contact with the second end such that the filter element and housing cooperate to define an unfiltered space and a filtered space.

10. (Original) The filter device of claim 9, wherein the housing includes a first aperture and a second aperture, the first aperture positioned to direct air from outside of the housing into the unfiltered space within the housing, and the second aperture positioned to receive air from the filtered space and direct the air out of the housing.

11. (Original) The filter device of claim 1, wherein the biasing element is integrally-formed with a bottom portion of the housing and wherein the bottom portion deflects in response to contact with the filter element.

12. (Original) The filter device of claim 1, wherein the housing is injection molded.

13. (Original) The filter device of claim 1, wherein the biasing element includes a cantilevered annular ring member.

14. (Original) The filter device of claim 1, wherein the housing includes a cover and the biasing element is formed integral with the cover.

15. (Original) The filter device of claim 14, wherein the cover includes at least one slot that at least partially defines the biasing element.

16. (Original) An air cleaner assembly for an engine, comprising:

a base including a filter support and a base engagement portion;

a filter element defining a longitudinal direction;

a cover including an integrally formed biasing element and a cover engagement portion, the base engagement portion interconnected with the cover engagement portion to position the biasing member adjacent the filter element to bias the filter element in the longitudinal direction.

17. (Original) The air cleaner assembly of claim 16, wherein the cover engagement portion includes at least one tab, and the base engagement portion includes at least one slot sized to receive the tab and to interconnect the cover portion to the base portion.

18. (Original) The air cleaner assembly of claim 16, wherein the biasing element includes a leaf spring formed as part of the cover, the leaf spring deflecting in response to contact with the filter element.

19. (Original) The air cleaner assembly of claim 16, wherein the biasing element is formed as part of a top portion of the cover.

20. (Original) The air cleaner assembly of claim 16, wherein the filter element includes a pleated filter media sandwiched between a first end cap and a second end cap.

21. (Original) The air cleaner assembly of claim 20, wherein the first end cap is in contact with the base and the second end cap is in contact with the biasing element such that the filter element, the cover, and the base cooperate to define an unfiltered space and a filtered space.

22. (Original) The air cleaner assembly of claim 21, wherein the cover includes a first aperture positioned to direct air from outside of the assembly into the unfiltered space, and wherein the base includes a second aperture positioned to receive air from the filtered space and direct the air out of the assembly.

23. (Original) The filter assembly of claim 16, wherein the biasing element is integrally-formed with a bottom portion of the base and wherein the bottom portion deflects in response to contact with the filter element.

24. (Original) The filter assembly of claim 16, wherein the base and cover are injection molded.

25. (Original) The filter assembly of claim 16, wherein the biasing element includes a cantilevered annular ring member.

26. (Original) The filter assembly of claim 16, wherein the cover includes at least one slot that at least partially defines the biasing element.

27. (Original) The filter assembly of claim 16, wherein the base engagement portion and the cover engagement portion are holes sized to receive a bolt.

28. (Original) A cover for use with an engine filter base and a filter element, the cover comprising:

a shell;

a biasing element integrally-formed as one piece with the shell;

an attachment portion connected to the shell and adapted to be interconnected to the filter base such that the filter element is sandwiched between the biasing element and the filter base.

29. (Original) The cover of claim 28, wherein the shell includes at least one aperture.

30. (Original) The cover of claim 28, wherein the shell, biasing element, and attachment member are injection molded as a single component.

31. (Original) The cover of claim 28, wherein the biasing element includes a leaf spring.

32. (Original) The cover of claim 28, further comprising a slot that at least partially defines the biasing element.

33. (Original) The cover of claim 32, further comprising a second slot disposed a distance from the first slot, the first slot and second slot cooperating to at least partially define the biasing element.

34. (Original) The cover of claim 28, wherein the attachment portion includes a tab, and the base includes a slot adapted to receive and engage the tab.

35. (Original) The cover of claim 28, wherein the attachment portion includes a slot, and the base includes a tab, the slot adapted to receive and engage the tab.

36. (Original) The cover of claim 28, wherein the cover further includes a second attachment portion.

37. (Original) The cover of claim 28, wherein the biasing member applies a force to the filter element, the force biasing the filter element toward the base.

38. (Original) The cover of claim 28, wherein the cover includes a first aperture positioned to direct air from outside of the cover into the unfiltered space within the cover.

39. (Original) The cover of claim 28, wherein the attachment portion is a hole sized to receive a bolt.

40. (Original) The cover of claim 28, wherein the attachment portion includes a cantilevered tab member integrally formed as part of the shell.

APPENDIX B

Evidence:

None.

APPENDIX C

Related Proceedings:

See attached Notice of Panel Decision from Pre-Appeal Brief Review dated April 7, 2006.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,763	10/07/2003	James Daleiden	018367-9798-00	5228

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ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

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Application Number	Application/Control No. 10/680,763	Applicant(s)/Patent under Reexamination DALEIDEN, JAMES	
	Duane S. Smith	Art Unit 1724	

Document Code - AP.PRE.DEC

Notice of Panel Decision from Pre-Appeal Brief Review

This is in response to the Pre-Appeal Brief Request for Review filed 2-22-06.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

   ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
   ☐ The request does not include reasons why a review is appropriate.
   ☐ A proposed amendment is included with the Pre-Appeal Brief request.
   ☐ Other:

   The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

   ☒ The panel has determined the status of the claim(s) is as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1-40*.
   Claim(s) withdrawn from consideration: _____.

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) *Duane S. Smith*. 3-30-06
(2) *Michael Colaianni*.
(3) *Minh-chau Pham*.
(4)_____.